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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,253	01/11/2002	Shin Muto	03500.016100.	6251
5514	7590	05/26/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			SERRAO, RANODHI N	
			ART UNIT	PAPER NUMBER
			2141	

DATE MAILED: 05/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/042,253

Applicant(s)

MUTO, SHIN

Examiner

Ranodhi Serrao

Art Unit

2141

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-5, 7-20, 22-31, 33-43, 46 and 47.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached Response to Arguments.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


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SUPERVISORY PATENT EXAMINER

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 21 April 2006 have been fully considered but they are not persuasive.
2. The applicant argued in particular that the applied art, Motoyama does not disclose a device being monitored generating data that indicates a setting screen to be displayed on an external apparatus, the setting screen being for setting destination information indicating a message destination, and transmitting the generated data to the external apparatus via a network. However, in col. 22, lines 23-44, Motoyama clearly points out that a device being monitored sending an email message that is going to be displayed on a computer (external apparatus) of the same company, or alternatively may be transmitted as an e-mail which remains within the private network such as the local area network or a wide area network (via a network) of a company. The service machine may then notify an appropriate entity through email. An email message inherently includes a destination setting screen, which is taught in figure 20 along with step 970 of figure 22. Therefore Motoyama does specify where the address can be set.
3. The applicant furthermore argued that the Kikinis reference fails to teach registering, for the same one electronic mail, a source destination and a reply destination that differ from each other. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., for the same one electronic mail) are not recited in the rejected claim(s). Although the claims are interpreted in light of the

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specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Explaining further, the applicant stated that this recitation means that one message has "from: origination A; reply to: organization A" addresses and another message has "from: organization B; reply to: organization A; reply to: organization B" addresses. However the abstract of Kikinis states "In an alternative embodiment, a "send to" address in a received e-mail, as a result of a table look-up, automatically prepares and sends a new e-mail identical to the received e-mail except for a new "send to" address retrieved from the stored table." Therefore Kikinis teaches the invention as claimed.

4. The examiner points out that the pending claims must be "given the broadest reasonable interpretation consistent with the specification" [*In re Prater*, 162 USPQ 541 (CCPA 1969)] and "consistent with the interpretation that those skilled in the art would reach" [*In re Cortright*, 49 USPQ2d 1464 (Fed. Cir. 1999)]. In conclusion, upon taking the broadest reasonable interpretation of the claims, the cited references teach all of the claimed limitations. And the rejections are reaffirmed. See below.

Claim Rejections - 35 USC § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-5, 7-11, 16-20, 22-26, 31, 33-37, 42, 46, and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Motoyama et al. (6,581,092).

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7. As per claims 1, 16, 46, and 47, Motoyama et al. teaches a data transfer processing apparatus which controls data transfer in a device (col. 5, lines 25-52), comprising: a status obtaining unit adapted to obtain status information about a status of said device (col. 8, lines 46-62); a message obtaining unit adapted to obtain a message according to the status information obtained by said status obtaining unit (col. 6, line 46-col. 7, line 4); a transmission data generation unit adapted to generate transmission data according to the message obtained by said obtaining unit and destination information indicating a message destination (col. 6, line 46-col. 7, line 4); an electronic mail transmission unit adapted to transmit as electronic mail the transmission data generated by said transmission data generation unit (col. 9, lines 44-52); a data generation unit adapted to generate data that indicates a setting screen to be displayed on an external apparatus, the setting screen being for setting said destination information (col. 22, lines 23-44); a data transmission unit adapted to transmit the data generated by said data generation unit to the external apparatus via a network (col. 12, line 46-col. 13, line 2); and a destination information reception unit adapted to receive the destination information set with the setting screen from the external apparatus via the network (col. 13, lines 3-48).

8. As per claims 2 and 17, Motoyama et al. teaches a data transfer process apparatus, further comprising a destination information storage unit adapted to store said destination information received by said destination information reception unit (col. 13, lines 3-48).

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9. As per claims 3 and 18, Motoyama et al. teaches a data transfer processing apparatus, wherein said electronic mail transmission unit transmits the electronic mail to a client apparatus through a mail server apparatus (col. 13, lines 3-48).

10. As per claim 4, Motoyama et al. teaches a data transfer processing apparatus, wherein: said data transfer processing apparatus is a network board connected to a printer (col. 5, lines 25-52); and said message obtaining unit obtains the message from the printer (col. 9, lines 44-52).

11. As per claims 5, 20, 31, and 42 Motoyama et al. teaches a data transfer processing apparatus which controls data transfer in a device, comprising: an information holding unit adapted to hold setting information set for transmission of an electronic mail containing a message depending on a status of the device (col. 10, lines 8-44); a data generation unit adapted to generate data indicating a setting screen to be displayed on an external apparatus, the setting screen being for setting the setting information; a data transmission unit adapted to transmit the data generated by said data generation unit to the external apparatus via a network (col. 12, line 46-col. 13, line 2); and a setting information reception unit adapted to receive the setting information set with the setting screen from the external apparatus via the network (col. 13, lines 3-48).

12. As per claims 7, 22, and 33, Motoyama et al. teaches a data transfer processing apparatus, wherein said setting information includes information indicating a condition of transmitting said electronic mail (col. 16, line 46-col. 17, line 8).

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13. As per claims 8, 23, and 34, Motoyama et al. teaches a data transfer processing apparatus, wherein said setting information includes information indicating a reply destination of said electronic mail (col. 11, line 59-col. 12, line 13).

14. As per claims 9, 24, and 35, Motoyama et al. teaches a data transfer processing apparatus, wherein said setting screen is for setting a pairing of a reply address of said electronic mail and a condition of transmitting said electronic mail (col. 16, lines 5-33 and col. 18, lines 43-59).

15. As per claims 10, 25, and 36, Motoyama et al. teaches a data transfer processing apparatus, wherein said message relates to a supplement of expendables used in the device, an exchange of expendables used in the device, or a process status of the device (col. 8, lines 14-31).

16. As per claim 11, Motoyama et al. teaches a data transfer processing apparatus, wherein said data transfer process apparatus is a network board connected to a printer (col. 5, lines 25-52).

17. As per claims 19, 26, and 37, Motoyama et al. teaches the device, wherein said device is a printer (col. 5, lines 25-52).

Claim Rejections - 35 USC § 103

18. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

19. Claims 12-15, 27-30, 38-41, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama et al. and Kikinis (2004/0267892).

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20. As per claims 12, 27, 38, and 43, Motoyama et al. teaches a data transfer processing apparatus which controls data transfer in a device, comprising: a status obtaining unit adapted to obtain status information about a status of said device (see Motoyama et al., col. 8, lines 46-62); a message obtaining unit adapted to obtain a message according to the status information obtained by said status obtaining unit (see Motoyama et al., col. 6, line 46-col. 7, line 4); a storage unit adapted to store destination information indicating a destination of an electronic mail (see Motoyama et al., col. 8, lines 46-62); a transmission data generation unit adapted to generate transmission data according to the message obtained by said message obtaining unit, the generated transmission data including the destination information and the reply destination information (see Motoyama et al., col. 6, line 46-col. 7, line 4); and an electronic mail transmission unit adapted to transmit as electronic mail the transmission data generated by said transmission data generation unit (see Motoyama et al., col. 9, lines 44-52). But fails to teach a registration unit adapted to register reply destination information indicating a reply destination of the electronic mail different from a source of the electronic mail. However, Kikinis teaches a registration unit adapted to register reply destination information indicating a reply destination of the electronic mail different from a source of the electronic mail (see Kikinis ¶ 18-19). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Motoyama et al. to a registration unit adapted to register reply destination information indicating a reply destination of the electronic mail different from a source of the electronic mail in order to

allow one agent to represent several different entities without the danger of inserting wrong or confusing data in e-mail replies (see Kikinis, ¶ 18).

21. As per claims 13, 28, and 39, Motoyama et al. and Kikinis teach a data transfer processing apparatus, further comprising: a data generation unit adapted to generate data that indicates a setting screen to be displayed on an external apparatus, the setting screen being for setting the destination information; a data transmission unit adapted to transmit the data generated by said data generation unit to the external apparatus via a network (see Motoyama et al., col. 12, line 46-col. 13, line 2); a reception unit adapted to receive the destination information and the reply destination information set with the setting screen from the external apparatus via the network, wherein said registration unit registers the reply destination information received by said reception unit (see Motoyama et al., col. 13, lines 3-48).

22. As per claims 14, 29, and 40, Motoyama et al. and Kikinis teach a data transfer processing apparatus, wherein said storage unit stores the reply destination information registered by said registration unit (see Motoyama et al., col. 13, lines 3-48).

23. As per claim 15, Motoyama et al. and Kikinis a data transfer processing apparatus, wherein said data transfer processing apparatus is a network board connected to a printer (see Motoyama et al., col. 5, lines 25-52).

24. As per claims 30 and 41, Motoyama et al. and Kikinis teach a device, wherein said device is a printer (see Motoyama et al., col. 5, lines 25-52).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ranodhi Serrao whose telephone number is (571)272-7967. The examiner can normally be reached on 8:00-4:30pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571)272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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